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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,342	03/12/2004	Dwight Allen Merriman	11032/3067	5601
23838 7590 09/03/2008 KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005				
EXAMINER LANEAU, RONALD				
ART UNIT 3714		PAPER NUMBER		
MAIL DATE 09/03/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,342

Applicant(s)

MERRIMAN ET AL.

Examiner

RONALD LANEAU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

1. The reply filed on 05/21/2008 has been entered. Claims 1-22 remain pending.

Response to Amendment

2. The Affidavit filed on 05/21/08 under 37 CFR 1.131 has been considered but is ineffective to overcome the Wexler and Goldhaber references.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Wexler and Godhaber references to either a constructive reduction to practice or an actual reduction to practice. There is no discussion whatsoever of diligence by the inventors, merely an allegation that the invention was reduced to practice "a few months after the business plan was shown to others.

Thus, Applicant has failed to established a showing of facts such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. See 37 CFR 1.131 (b) Affidavit or declaration of prior invention to overcome cited patent or publication. Therefore, Wexler, and Goldhaber are not removed as prior art as requested by Applicant at this point in prosecution and the rejections under those references are maintained. The claims continue to be rejected over these references.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 5,960,409) in view of Goldhaber et al (US 5,794,210).

As per claims 1 and 9, Wexler teaches a method for advertising, comprising: receiving an advertisement request 11a from a user node 3, wherein said advertisement request is based upon a link 7 sent from an affiliate node 13 to said user node 3 in response to a content request 15a sent from said user node 3 to said affiliate node 13 (col. 4, lines 28-40 and 54-57). Wexler does not explicitly disclose the selecting an advertisement based on stored information but Goldhaber discloses selecting, in response to said advertisement request, an advertisement based upon stored information about said user node (col. 14, lines 17-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selecting step as disclosed by Goldhaber into the method of Wexler because it would allow the advertisers to target their advertisements to a subset of the general population that may be more likely to respond to the advertisements and also assure that its advertising is delivered to the consumers most likely to purchase its products.

As per claims 2-7, the limitations of "content of the stored information" has no weight since they are non-functional descriptive material. They are however rejected under the combination of Wexler and Goldhaber (see claim 1).

As per claim 8, the combination of Wexler and Goldhaber would disclose a method wherein selecting an advertisement is further based upon an operating system type, each associated with said user node as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the same reasons given in claim 1.

As per claims 10-14, Goldhaber discloses a system wherein if selection criteria associated with more than one advertisement are satisfied based upon said stored information, then calculating a satisfaction index for each advertisement (see fig. 11A, 182), and selecting the advertisement with the lowest satisfaction index, wherein said satisfaction index for an advertisement is directly proportional to the number of times said advertisement is sent to a user node, wherein said satisfaction index for an advertisement is inversely proportional to the amount of time expired since said advertisement was first permitted to be sent to a user node (see Goldhaber, fig. 11A, scanning for matching ads and screening for used ads), wherein said satisfaction index for an advertisement is inversely proportional to the maximum number of times the advertisement is permitted to be sent to a user node, wherein said satisfaction index for an advertisement is directly proportional to the total amount of time over which said advertisement is permitted to be sent (see Goldhaber, fig. 11A, by indexing each ad, the system is actually counting the number of times this ad has been sent to a user node as claimed).

As per claim 15, Wexler discloses a method wherein an advertisement request would include an Internet Protocol address associated with a user node as claimed (see fig. 2).

As per claim 19, Goldhaber teaches a system further comprising sending said selected advertisement to said user node for display (col. 18, lines 57-69).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the advertisement selection for display as taught by Goldhaber into the method of Wexler because it would allow the system to monitor the user's activities and record the interests of the user based on time spending looking at the ad.

As per claims 20-22, the combination of Wexler and Goldhaber would disclose a system comprising receiving from said user node a click through request for information about the advertiser associated with said selected advertisement, further comprising sending a network address for said advertiser to said user node in response to said click-through request, wherein said stored information includes information about a prior click-through request received from said user node (see Wexler, col. 3, line 65 to col. 4, lines 9, see abstract; see Goldhaber for the selection step).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Wexler and Goldhaber for the same reasons discussed previously.

5. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 5,960,409) in view of Goldhaber et al (US 5,794,210) and further in view of Funk et al (US 5,937,162).

As per claims 16-18, neither Wexler nor Goldhaber discloses a system for performing a reverse domain and for selecting an advertisement based on the results of said reverse domain but Funk discloses a system performing a reverse domain lookup table based upon an internet protocol address, selecting an advertisement based upon the results of said reverse domain and

perform a trace operation route (see claim 1; reverse domain is querying a domain name server (DNS) to determine the corresponding domain name).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the selecting step as disclosed by Goldhaber into the method of Wexler because it would allow the advertisers to target their advertisements to a subset of the general population that may be more likely to respond to the advertisements and also assure that its advertising is delivered to the consumers most likely to purchase its products. It would have been obvious to one of ordinary skill in the art to utilize the domain name querying system as taught by Funk into the combined systems of Wexler and Goldhaber because it would provide a system that can send a unique, customized advertisement to a group of selected users and allow them to click and see the ad on the display screen.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to RONALD LANEAU at telephone number (571)272-6784.

/Ronald Lancau/
Primary Examiner
Art Unit 3714

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